



Attorney Docket No. INE 005 CIP

PATENT
#13/12

05-13-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
Powell et al)
Serial No. 09/842,511)
Filed: April 26, 2001)
Examiner: Susan Coe)
Art Unit: 1654)
For: PROCESS FOR THE)
EXTRACTION OF A COMPOUND)
BY A FLUOROCARBON)
COMPOUND)

CERTIFICATE OF MAILING

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REPLY TO SECOND OFFICE ACTION
REQUIREMENT FOR RESTRICTION & ELECTION OF SPECIES

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a reply to the second Official Office Action mailed April 17, 2003 in the above-captioned application.

At the time of the second Official Office Action, claims 38-63 were pending in the application. Of these claims, claims 38 and 46 were independent claims.

The earlier first Office Action (Paper No. 7) mailed December 31, 2002 was not on the merits. It was only a requirement for restriction between the following inventions:

- I. Claims 38-45 and 51-58 drawn to a process for extracting a "compound"; and
- II. Claims 46-56 and 59-63 drawn to a process for extracting a "compound" from a "plant".

Pursuant to that restriction requirement, applicants elected the Group I claims 38-45 and 51-58 for further prosecution, reserving the right to file whatever divisional applications may be necessary to protect the subject matter of the non-elected Group II. The election was made with traverse and an argument was presented as to why the restriction requirement was improper and should be withdrawn.

In this second Office Action it appears that the identical requirement for restriction between inventions has been repeated verbatim without any acknowledgement of applicants' prior election between inventions or their arguments traversing the restriction requirement.

Again, applicants hereby elect the Group I claims 38-45 and 51-58 for further prosecution, reserving the right to file whatever divisional applications may be necessary to protect the subject matter of the non-elected Group II.

This election is again made with traverse.

Again it is respectfully requested that the requirement for restriction between inventions be reconsidered and withdrawn in view of the fact the difference between the Group I and Group II claims is simply a matter of breadth and not invention. The Group I claims are directed to a process for extracting broadly a "compound or composition" from a "raw material", whereas the Group II claims are simply narrower to the extent that the "compound or composition" is specified to be a "natural product" and the "raw material" is specified to be a "plant material". Thus, if the Group I claims, and particularly independent claim 38, is found to be allowable, all of the group II claims would also be allowable over the prior art without further search.

Accordingly, it is again respectfully requested that the requirement for restriction between Groups I and II be reconsidered and withdrawn.

In the first Office Action (Paper No. 7) mailed December 31, 2002, applicants were also required to elect the between 14 specific species which were identified for the Group I and Group II claims respectively. The species were: 1) biologically active compound, 2) a pharmaceutically active substance, 3) a flavored composition, 4) an aromatic composition, 5) a cytochalasin, 6) a monensin, 7) a pyrethroid, 8) a pesticide, 9) a penicillin, 10) an alkaloid, 11) paclitaxel, 12) taxane, 13) a flavored oil, and 14) an aromatic oil. These are the same 14 species as are set forth as Species A in the second Office Action.

In reply to the first Office Action, applicants previously elected species 3) a flavored composition, and argued that species 3, 4, 13 and 14 should be included together.

The second Office Action, again which is not on the merits, requires an even more rigorous election of species than before between:

- A) an extracted substance selected from a biologically active compound, a pesticide, a pyrethroid, a pharmaceutically active substance, penicillin, an alkaloid, paclitaxel, taxane, monensin, cytochalasin, flavored composition, flavored oil, aromatic composition or aromatic oil;
- B) a hydrofluorocarbon selected from difluoromethane, pentafluoroethane, hydrofluoropropane, or 1,1,1,2,3,3,3-heptafluoropropane; and
- C) a co-solvent selected from a C₂₋₆ hydrocarbon, a C₂₋₄ alkane, dialkyl ether, dimethyl ether, butane or a mixture of dimethyl ether and butane.

Applicants hereby elect the following species:

- A. the flavored composition (as they elected before);
- B. 1,1,1,2,3,3,3-heptafluoropropane; and
- C. the C₂₋₄ alkane.

As in the reply to the first Office Action election of species requirement, this election of species is also made with traverse.

Again, applicants also request reconsideration of the requirement for election between at least some of the stated species. Specifically, applicants request reconsideration of the requirement for election between the following Species A:

- 3) a flavored composition;
- 4) an aromatic composition;
- 13) a flavored oil; and
- 14) an aromatic oil.

Applicants are surprised by the Examiner's conclusion that "flavored" and "aromatic" products are distinct from each other. The senses of smell and taste are very closely related. For example, much of the flavor experience of food derives from the sense of smell since only the taste receptors in humans are for sweet, sour, salt, and bitter taste. Thus, it is not believed that flavors and aromas are that distinct from each other. Moreover, it is not believed that "compositions" and "oils" merit species distinction because if a "composition" is found to be patentable, the "oil" should also be patentable for the reasons stated above with respect to the restriction between inventions, i.e. "composition" is a broad term which would be inclusive of many things including the more narrow "oil".

Accordingly, it is respectfully requested that the requirement for election of species between the four last mentioned species be reconsidered and withdrawn.

The elected Group I claims 38-40 and 51, 53, 56 and 57 are generic to and readable on the elected flavored composition species A, and the elected species B and C.

If the requirement for restriction between Groups I and II is withdrawn as requested herein, Group I and Group II claims 38-40, 46-49, 51, 53, 56 and 57 are generic to and readable on the elected flavored composition species A, and the elected species B and C.

If the requirement for restriction between Groups I and II is withdrawn as requested herein, and the requirement for election between species

3) a flavored composition; and

4) an aromatic composition

is also withdrawn as requested herein, claims 38-40, 46-49, 51, 53, 56 and 57 are generic to and readable thereon.

If the requirement for restriction between Groups I and II is withdrawn as requested herein, and the requirement for election between species

3) a flavored composition;

4) an aromatic composition;

13) a flavored oil; and

14) an aromatic oil

is also withdrawn as requested herein, claims 38-40, 46-51, 53 and 56-58 are generic to and readable thereon.

If the requirement for restriction between Groups I and II is not withdrawn, but the requirement for election between species

3) a flavored composition; and

4) an aromatic composition

is withdrawn as requested herein, Group I claims 38-40, 51, 53, 56 and 57 are generic to and readable thereon.

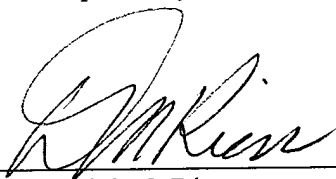
Finally, if the requirement for restriction between Groups I and II is not withdrawn, but the requirement for election between species

- 3) a flavored composition;
- 4) an aromatic composition,
- 13) a flavored oil; and
- 14) an aromatic oil

is withdrawn as requested herein, claims 38-40, 50, 51, 53 and 56-58 are generic to and readable thereon.

Early reconsideration of the restriction and election of species requirements, examination and allowance are requested.

Respectfully submitted,



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